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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,536	07/18/2005	Donna Hui-Ing Hwang	3975.043	7321
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AKERMAN SENTERFIT			EXAMINER	
P.O. BOX 3188			SOROUSH, LAYLA	
WEST PALM BEACH, FL 33402-3188				
			ART UNIT	PAPER NUMBER
			1617	
			NOTIFICATION DATE	DELIVERY MODE
			10/05/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip@akerman.com

### Office Action Summary

**Application No.**

10/542,536

**Applicant(s)**

HWANG ET AL.

**Examiner**

LAYLA SOROUSH

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,15-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,15-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2009. Claims 10, 15-18, and 20 are pending.

In view of applicants' amendments to the claims, the following rejections are made:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 15-18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what Applicant means by "ad 100% by weight of cosmetic carrier..."

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles ( WO 86/05389 – IDS (previously presented)) view of Elks et al. (US 3376193), Robinson (2003/0049212), Schreiber(4187287), Mcosker et al. (2001/0003565), and Magauran et al. (US 5340390 A).

Mackles teaches in Example 1 Valfor 950 (zeolite) in 35%, Cabosil M-5 (thickener) in 0.5%, decaglycerol tetraoleate (emollient) in 6%, polyethylene glycol 400 dioleate (nonionic surfactant) in 2%, and partially hydrogenated soybean oil (triglycerides) in 51.20% (p.13 lines 9-17) of a composition. The delivery system of Mackles provides a soft, silky, and cosmetically elegant feel to the skin (p.3 lines 5-9). Mackles generally teach the particles comprising 10-50 wt% of the composition (see claim 3). Additionally, the foaming agents are preferably used in 3-15 wt% of the composition(p 7 line 17).

Elks et al. is solely used to show an aerosol spray lotion (see Example i).

The exemplified composition does not contain the specific zeolite with a Si/Al ratio in the range of 2-5:1 and thickeners as recited in claim 1.

Robinson teaches topical composition comprising zeolites. The preferred zeolites are, i.e., sodium silicoaluminates available from UOP Molecular Sieves (see examples 16-18 MOLSIV adsorbent 3A) and Zeolex 23A (Valfor 950) (p.3 [0050] and p.28 [0345]). The MOLSIV adsorbent 3A compounds meet the limitation for "a zeolite with a Si/Al ratio in the range of 2-5:1.

Schreiber is solely used to show that the type and amount of zeolite is the cause for variation in the rise of temperature in water. More specifically, the composition comprising zeolite 3a showed a change in temperature of 8C (col 11 and 12).

Mcosker et al. teaches suspending agents are inclusive of untreated fumed silica (Cabosil M-5) and castor oil derivatives.

Magauran et al. is solely used to show that castor oil derivatives include castor wax.

It would be obvious to one of ordinary skill in the art to substitute the Valfor 950 for MOLSIV adsorbent 3A and Cabosil M-5 for castor oil derivatives. The motivation to make such a substitution is because both zeolites and thickening agents are taught to be useful in topical compositions, furthermore, the zeolites provide heating properties and the thickeners provide various suspension properties. Therefore, a skilled artisan would have reasonable expectation of producing a stable topical composition with desired heating and suspension properties. Additionally, the determination of optimal or workable percentage of zeolites by routine experimentation is obvious. One having ordinary skill in the art would have been motivated to do this to obtain the desired heating properties of the composition.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles ( WO 86/05389 – IDS (previously presented)) view of Elks et al. (US 3376193), Robinson (2003/0049212), Schreiber(4187287), Mcosker et al. (2001/0003565), and

Magauran et al. (US 5340390 A) as applied to claims 10, 13-14, and 16, 20 above, and further in view of Bergmann et al. (6,274,128 previously presented).

Mackles is as discussed above.

Mackles fails to teach the specific dispersed oil caprylic/Capric triglyceride.

Bergmann et al. teaches a self-warming hair conditioning composition wherein conditioners of the composition are hydrocarbons inclusive of caprylic/Capric triglyceride and wax (col 4, lines 50-67 and col 5, lines 1-5).

It would be obvious to one of ordinary skill in the art at the time of the invention to incorporate caprylic/Capric triglyceride into a self-warming hair composition. The motivation to make such an incorporation is because the caprylic/Capric triglyceride and wax are conditioners. Hence, a skilled artisan would have reasonable expectations of successfully producing a self-warming hair conditioning composition with similar conditioning properties.

Claims 17, and 18, is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles ( WO 86/05389 – IDS (previously presented)) view of Elks et al. (US 3376193), Robinson (2003/0049212), Schreiber(4187287), , Mcosker et al. (2001/0003565), and Magauran et al. (US 5340390 A), as applied to claims 10, 13-14, and 16, 20 above, and further in view of Mackles et al. (US Pat. No. 5,322,683 (previously presented)).

Mackles is as discussed above.

Mackles fails to teach the method of cleansing as claimed.

Mackles ('683) teaches a self-heating foam composition comprising aluminosilicates useful as a hair conditioner and facial cleanser.

To a person with ordinary skill in the art at the time the invention was made it would be obvious to modify the self-heating foam composition to provide a facial cleansing composition. The motivation to make such a modification is because (1) both have similar compositions with similar self-heating foam properties, and, therefore, the interchangeable use of either one will successfully yield similar results.

### **Response to Arguments**

Applicant's arguments filed September 19, 2009 have been fully considered but are not persuasive.

Applicant argues Mackles teaches decaglycerol tetraoleate as foaming agent and not an emollient. The Examiner states that the decaglycerol tetraoleate can act as both an emollient and a foaming agent. Additionally, the foaming agents are preferably used in 3-15 wt% of the composition. So it would be obvious that one of ordinary skill in the art to modify the amount of decaglycerol tetraoleate because the prior art teaches a suitable range is between 3-15 wt% of the composition.

With respect to the argument that the foam composition of the prior art is not the same as the composition claimed is not persuasive. Elks et al. is solely used to show an aerosol spray lotion (see Example i). Hence, the composition of Mackles still reads on the claimed invention.

The argument with respect to the amount of hydrophilic aluminum rich zeolite and emollient is not persuasive. Mackles in fact teaches the particles comprising 10-50

wt% of the composition (see claim 3). Additionally, the foaming agents are preferably used in 3-15 wt% of the composition (p 7 line 17). So it would be obvious that one of ordinary skill in the art could modify the amount of decaglycerol tetraoleate because the prior art teaches a suitable range is between 3-15 wt% of the composition.

In response to applicant's argument that Robinson and Bergmann et al. teaches polyvalent alcohols, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Robinson was used for the teaching that topical composition comprising zeolites, i.e., sodium silicoaluminates available from UOP Molecular Sieves (see examples 16-18 MOLSIV adsorbent 3A) and Zeolex 23A (Valfor 950) (p.3 [0050] and p.28 [0345]). The MOLSIV adsorbent 3A compounds meet the limitation for "a zeolite with a Si/Al ratio in the range of 2-5:1." It would be obvious to one of ordinary skill in the art to substitute the Valfor 950 for MOLSIV adsorbent 3A and Cabosil M-5 for castor oil derivatives. The motivation to make such a substitution is because both zeolites and thickening agents are taught to be useful in topical compositions; furthermore, the zeolites provide heating properties and the thickeners provide various suspension properties. Further, Bergmann et al. teaches a self-warming hair conditioning composition wherein conditioners of the composition are hydrocarbons inclusive of caprylic/Capric triglyceride and wax (col 4, lines 50-67 and col 5, lines 1-5).



It would be obvious to one of ordinary skill in the art at the time of the invention to incorporate caprylic/Capric triglyceride into a self-warming hair composition. The motivation to make such an incorporation is because the caprylic/Capric triglyceride and wax are conditioners. Hence, a skilled artisan would have reasonable expectations of successfully producing a self-warming hair conditioning composition with similar conditioning properties.

Examiner respectfully reiterates: Applicant's 132 Declaration has been considered but is not persuasive. The Schreiber reference above is solely used to show that the type and amount of zeolite is the cause for variation in the rise of temperature in water. More specifically, the composition comprising zeolite 3a showed a change in temperature of 8C (col 11 and 12). Hence, Applicants argument that the MOLSIV adsorbent 3A shows higher rise in temperature as opposed to the Valfor 950 is not an unexpected property of the known compound. Additionally, because both the MOLSIV and Valfor 950 compounds are known to be useful in topical formulations it would be obvious to one of ordinary skill in the art to substitute the Valfor 950 for MOLSIV adsorbent 3A. The motivation to make such a substitution is because both zeolites provide heating properties. Therefore, a skilled artisan would have reasonable expectation of producing a stable topical composition with desired heating properties.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/

Art Unit: 1617

Supervisory Patent Examiner, Art Unit 1617